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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,404	08/12/2003	Nachman Eckstein	26253	5156

7590

02/03/2006

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EXAMINER

PRASAD, SONAL

ART UNIT

PAPER NUMBER

3767

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/638,404	<b>Applicant(s)</b> ECKSTEIN ET AL.	
	<b>Examiner</b> Sonal Prasad	<b>Art Unit</b> 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 11, 13, 16-18 and 67 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 12, 14, 15, 19, & 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/19/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-3,6, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ranoux (US 5,084,004) in view of Saunders et al. (US 3,073,246). Ranoux discloses a housing having, at one end, an expansible-contractible chamber for receiving a quantity of said fluid-like substance (Fig. 2 a-c), and an outlet for discharging said substance upon the contraction of said chamber (Fig. 2 a-c); said housing comprising a first section housing said expansible-contractible chamber and a second section housing said drive; said first housing section being attachable to and detachable from said second housing section to permit disposal of said first housing section, including said expansible-contractible chamber after a one-time use. (Fig. 7 & 8). The claim differs from Ranoux in disclosing the motorized syringe and a drive at the opposite end

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of said housing. Saunders discloses said drive including an electrical motor and a plunger driven by said electrical motor for contracting said chamber to discharge said substance via said outlet. (Column 1, line 56) It would have been obvious at the time of invention to one of ordinary skill in the art to include a motorized syringe and a drive to improve the function and efficiency of the device.

Regarding claim 2, Ranoux discloses the motorized syringe wherein said first and second housing sections include interconnecting elements at one of their ends for attaching and detaching said housing sections with respect to each other in a quick manner. (Fig. 7 &8)

Regarding claim 3, Ranoux discloses the motorized syringe wherein said interconnecting elements are external threads formed in one of said housing sections receivable in internal threads formed in the other of said housing sections. (Fig. 5, #431)

Regarding claim 6, Ranoux discloses the motorized syringe wherein said outlet includes a flexible catheter tube of a length to deliver the discharged substance to a desired location. (Fig. 3, #201)

Regarding claim 7, Ranoux discloses the motorized syringe wherein said drive includes a threaded sleeve fixed to said plunger (Fig. 1e,#23) a threaded shaft engageable with said threaded sleeve (Fig. 3,#205) for axially displacing the sleeve and the plunger fixed thereto upon the rotation of said shaft, and a step-down transmission coupling said threaded shaft to said motor for rotating said shaft, and thereby for axially displacing

said sleeve and plunger fixed thereto at a slow rate upon the energization of said motor.  
(Fig 1e)

Regarding claim 8, Ranoux discloses a motorized syringe wherein said housing is of a bio-compatible material suitable for introduction into a cavity of a patient's body for delivering a medical preparation thereto at a slow rate for a prolonged period of time.  
(Col 9, line 30)

Regarding claim 9, Ranoux discloses the motorized syringe wherein said motorized syringe further comprises a motor control circuit included in a separate unit having mounting means for mounting the separate unit externally of the patient's body. (Fig. 1,4,8)

Regarding claim 10, Ranoux discloses the motorized syringe wherein said housing is sized and configured for introduction into the vagina of a human female and includes a flexible catheter tube of a length for introduction into the uterus of the female. (Fig. 1f)

Regarding claim 11, Ranoux discloses a motorized syringe for producing a controlled, slow-delivery of a fluid-like substance (Fig. 1c), comprising: a housing having, at one end, an expansible-contractible chamber for receiving a quantity of said fluid-like substance (Fig. 1), and an outlet for discharging said substance upon the contraction of said chamber (Fig. 8), as well as a threaded shaft engageable (Fig. 1e) with said

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threaded sleeve for axially displacing the sleeve and the plunger fixed thereto upon the rotation of the threaded shaft (Fig. 1e) and a step-down transmission coupling said threaded shaft to said motor for rotating said shaft, and thereby for axially displacing said sleeve and plunger. (Fig. 3,8) The claim differs from Ranoux in disclosing a drive. Saunders et al discloses the drive at the appropriate end of said housing, said drive including an electrical motor and a plunger driven by said electrical motor for contracting said chamber to discharge said substance via said outlet; said drive including a threaded sleeve fixed to said plunger. (Column 1, 50-56) It would have been obvious at the time of invention to one of ordinary skill in the art to include a drive to improve the function and efficiency of the device.

Regarding claim 13, Ranoux discloses the motorized syringe wherein said first and second housing sections include interconnecting elements at one of their ends for attaching and detaching said housing sections with respect to each other in a quick manner. (Fig 1,4,8)

Regarding claim 16, Ranoux discloses the motorized syringe wherein said outlet includes a flexible catheter tube of a length to deliver the discharged substance to a desired location. (Fig. 8)

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Regarding claim 17, Ranoux discloses the motorized syringe wherein said housing is of a bio-compatible material for introduction into a cavity of a patient's body for delivering a medical preparation (Col 9, line 30) thereto at a slow rate for a prolonged period of time, and said motorized syringe further comprises a motor control circuit included in a separate unit having mounting means for mounting the separate unit externally of the patient's body. (Fig. 8)

Regarding claim 18, Ranoux discloses the motorized syringe wherein said housing is sized and configured for introduction into the vagina of a human female and includes a flexible catheter tube of a length for introduction into the uterus of the female. (Fig. 8)

***Allowable Subject Matter***

4. Claims 4,5,12,14, 15, 19, &20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The claims would be allowable due to the blows-type container receivable within the first housing, the expansible-contractible chamber, detachable housing after one time use, the septum for filling the expansible-contractible chamber by injection, as well as the method for energizing said motorized syringe to deliver said semen preparation to the uterus at a slow flow rate.

**Conclusion**

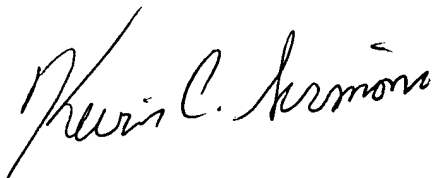
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonal Prasad whose telephone number is 571-272-3383. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sonal Prasad  
Examiner  
Art Unit 3767

SP

A handwritten signature in black ink, reading "Kevin C. Sirmons". The signature is written in a cursive, flowing style.